



Recommended Practices on the Admissibility of Internet Information as Prior Art for Novelty and Obviousness Examinations

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I. Introduction

Novelty, i.e., being new, is a fundamental and universally applied requirement for the legal protection of industrial designs. Intellectual property offices have been utilizing reliable published design information such as design bulletins issued by IP offices and other publication materials (e.g., magazines, brochures, etc.) publicly available to IP offices and their examiners for the purposes of conducting novelty examinations.

Information containing new designs is continuously made public and accumulated day after day. The internet has exponentially increased the amount of design information made public each day. However, the reliability and stability of design information on the internet poses new challenges than traditional print publications. For example, publication information such as time and dates for specific design information is more difficult to verify compared to traditional publication mediums such as design bulletins and other periodicals.

The present project has aimed to deepen a mutual understanding of the practices regarding design information found on the internet. Additionally, these recommended practices are intended to provide offices conducting examinations and users (who are assumed to be demandants mainly in the procedures for invalidation of design registrations) with a more consistent and reliable environment for design protection.

II. Recommendations

The joint recommendations are as follows.

Recommendation 1

<Handling of publication on the internet in determining novelty of industrial designs>

Information that is publicly available on the internet can be considered when determining novelty and obviousness for industrial designs.

Recommendation 2

<Considerations regarding publication of industrial designs on the internet>

When determining if information on the internet is to be considered for the purposes of determining novelty and obviousness it is important whether the information was accessible to a person who is interested in it.

For that reason, office examiners and users can take into consideration the following factors, for example:

- Whether information is commonly available via the internet;*
- Whether information is password-protected *;*
- Whether information is encrypted;*
- Whether information is posted on an intra-company site and what is the level of access provided on such site, i. e., whether the information is accessible to all employees or to only a part of employees;*
- Whether information is available via commercial online databases;*
- Whether information is listed and treated as confidential; and*
- Whether information is available for a fee *.*

** In general, neither restricting access to a limited circle of people by password protection, nor requiring payment for access would prevent a design that has been made available on a webpage, app or file sharing platform from forming the prior art. Nevertheless, this might depend on the specific circumstances of a particular case.*

(Information contained in e-mails)

When determining if information presented in an email is to be considered for the purposes of determining novelty and obviousness it is important to consider whether the information was accessible to a person who is interested in it.

For that reason, office examiners and users particularly should consider the following factors, for example:

- Comprehensive evaluation of contents, recipients and purpose of e-mail;*
- Whether the email is a privileged communication between attorney and client.*

Recommendation 3

<Information with the reliable date and time of publication on the internet>

The following sources may generally be considered reliable and can be cited by office examiners and users as of the date and time indicated within the noted publications:

- Publications of official bulletins issued by IP offices, government agencies and WIPO retrieved via the internet;*
- Information available on the website of public organizations (government agencies);*
- Information available on the website of international organizations (standardization organizations, etc.);*
- Information available on the website of established academic institutions (scientific societies, universities, etc.); and*
- Information available on the website of publishers or newspapers.*

NOTE: These information sources should not be considered to cover all. In addition, offices may not rely on information in certain circumstances due to the potential lack of reliability.

Recommendation 4

<Direct means to clarify the date and time of publication on the internet>

The following can be considered when office examiners and users determine the time and date of an internet publication:

- Date and time as indicated in news article publications;*
- Date and time recorded in snapshots of the order coming from e-shopping platforms and other commercial websites; and*
- Date and time notarized by certified timestamp.*

Note: Regarding timestamps, the following can be noted:

- E-timestamp, with accurate specifying of time, can demonstrate that contents such as files, messages, transactions, or graphic images, etc. existed at a certain point of time.*
- The “Date and time notarized by certified timestamp” refers to the time when the timestamp was made, and in the case where screenshot images were timestamped, it certifies that such contents were available for use on the date and time shown by the timestamp;*
- Timestamping could be used as a precautionary measure in order to secure the evidence of disclosure of designs; and*
- When several steps are required in order to obtain the evidence of design disclosure, the entire browsing session could be timestamped.*

Recommendation 5

<Auxiliary means to clarify the date and time of publication on the internet>

The following are possible action(s) that office examiners and users may take when there is some discrepancy related to the earliest availability of the internet information cited:

- To obtain supporting information using internet archive sites;*
- To obtain supporting information using multiple information sources;*
- To obtain information on the date and time when a file was downloaded to a platform; and*
- To obtain information on the date and time of an e-mail to be notified when a document is published or file is shared.*

Recommendation 6

<Items when offices clearly provide the sources of evidence found>

For the purposes of transparency and efficiency, office examiners can consider providing the following information/evidence when communicating with applicants when citing internet information:

- Name of the author (name of the person who created the HTML documents in which the cited design is posted.);*
- Indication that the source of information is the internet;*
- Title of the web page on which the internet information was available;*
- Specific location on the web page where the graphic image of the cited design is located;*
- Date on which the internet information was published/posted;*
- Date on which the examiner searched the internet information;*
- Indication of the URL of the web page (In case that the URL contains multi-byte characters, it is recommended to indicate the encoded URL.);*
- Graphic image of the cited design;*
- Screenshot(s) of internet information on which graphic images of a published design are posted (documentary evidence); and*
- Information to certify the date and time of publication (documentary evidence).*

Recommendation 7

<Items when users clearly provide the sources of evidence found on the internet>

When demandants submit internet information in the procedures for invalidation of design registrations, the following details could be included in information/evidence:

- Indication that the source of information is the internet;*
- Date on which the internet information was published/posted;*
- Date on which the demandant retrieved the internet information (e. g. a hard copy of the web page which contains the date);*
- Indication of the URL of the web page (In case that the URL contains multi-byte characters, it is recommended to indicate the encoded URL.) ;*
- Graphic image or video of the cited design;*
- Screenshot(s) of internet information on which graphic images of a published design are posted (documentary evidence) ; and*
- Information to certify the date and time of publication (documentary evidence).*

Among these, providing the following information is particularly considered important:

- Screenshot(s) of internet information that has not been manually modified and clearly indicates the date and images of published designs. (documentary evidence)*

Other than the information/evidence listed above, it is also considered important to provide the following information/evidence:

- Original source of the internet information posted on the web page and the way to access the web page (should be accompanied by the screenshots);*

- *Title of the web page on which the internet information was available for use;*
- *Specific location on the web page where the graphic image or video of the cited design is located;*
- *Screenshot(s) of mobile devices when apps (in particular, those associated with online sales, auctions, social networking, etc.) are activated, including the date when the screenshot was taken;*
- *Email date, recipient(s), purpose (attached file if necessary);*
- *Name of file-sharing service, sharer, purpose and content.*